

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Arthur B. RAITANO et al.

Application No.: 10/764,390

Confirmation No.: 2022

Filed: January 23, 2004

Art Unit: 1643

For: NUCLEIC ACIDS AND CORRESPONDING
PROTEINS ENTITLED 254P1D6B USEFUL IN
TREATMENT AND DETECTION OF
CANCER

Examiner: K. Canella

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705

MS Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

On behalf of applicants, the undersigned requests reconsideration of the patent term adjustment indicated in the Notice of Allowance. This application for patent term adjustment is being filed with payment of the issue fee and is, therefore, timely. The fee required under 37 CFR 1.705(b)(1) as set forth in 37 CFR 1.18(e) is enclosed with the present application.

Correct Patent Term Adjustment

Applicants respectfully request a credit of 85 days be added to the 0 days of adjustment as indicated on the Notice of Allowance.

Statement of Facts

According to the Office's Initial Determination of Term Adjustment received with the Notice of Allowance, mailed October 31, 2008, applicants are entitled to 0 days adjustment of patent term. Applicants disagree with the Patent Term Adjustment of 0 days and reconsideration is respectfully requested.

The Office failed to mail a notification under 35 USC 132 or a notice of allowance under 35 USC 151 within 14 months of the filing date of the present application. The Office correctly credits applicants 97 days of adjustment in accordance with 35 USC 154(b)(1)(A)(i) and 37 CFR 1.702(a)(1), 1.703(a)(1).

Applicants filed a response on May 18, 2006 to a non-final office action, mailed February 15, 2006. The Office correctly calculates 3 days of applicants' delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Applicants filed a response on December 15, 2006 to a non-final office action, mailed August 8, 2006. The Office correctly calculates 37 days of applicants' delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Applicants' December 15, 2006 response contained a non-compliant amendment. Applicants filed a response correcting the non-compliant amendment on January 30, 2007. The Office correctly calculates 46 days of applicants' delay in accordance with 37 CFR 1.704(b).

Applicants filed a request for continued examination on June 15, 2007 in response to a final rejection, mailed March 9, 2007. The Office correctly calculates 6 days of applicants' delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Applicants filed a response on November 13, 2007 to a non-final office action, mailed July 12, 2007. The Office correctly calculates 32 days of applicants' delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Applicants filed a request for continued examination on May 9, 2008 in response to a final rejection, mailed January 9, 2008. The Office correctly calculates 30 days of applicants' delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Based on a projected issue date of May 12, 2009, the Office will fail to issue a patent within 3 years after the date on which the present application was filed (January 23, 2004). Based on this projected issue date, applicants are entitled to an additional credit of 142 days in accordance with 35 USC 154(b)(1)(B) and 37 CFR 1.702(b), 1.703(b).

Under the USPTO's Exclusion Interpretation of 35 USC 154(b)(2)(A) and application of 37 CFR 1.703(f) Actual Delay Limitation, the Office would conclude that the 97 days of adjustment for failure to issue an action constitute "overlap" with the 142 days of adjustment for failure to issue a patent within 3 years and thus, would not include the 97 days in the total calculation of term adjustment.

In light of Wyeth et al. v. Dudas, No. 07-1492 (D.D.C. September 30, 2008), Applicants assert that the Actual Delay Limitation under 37 CFR 1.703(f) is no longer applicable and thus, the 142 days of delay under the 3-Year PTO Issue of Patent rule should be added to the 97 days of delay under the 14-Month PTO First Action rule.

Applicants calculate a total PTO delay of 239 days and applicants' delay of 154 days, for a revised total of 85 days of additional patent term. Based on the foregoing information, applicants respectfully request reconsideration of the patent term adjustment.

Conclusion

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection

with the filing of this document to Deposit Account No. 03-1952 referencing Docket No. 511582008100.

Dated: January 30, 2009

Respectfully submitted,

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